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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/075,283	02/15/2002	Makoto Iwayama		9044

24956 7590 08/18/2006

MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C.
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SUITE 370
ALEXANDRIA, VA 22314

EXAMINER

ABEL JALIL, NEVEEN

ART UNIT	PAPER NUMBER
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2165

DATE MAILED: 08/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/075,283

Applicant(s)

IWAYAMA ET AL.

Examiner

Neveen Abel-Jalil

Art Unit

2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/7/2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10 and 18 is/are rejected.
- 7) ☒ Claim(s) 11-17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Remarks

1. The Amendment filed on August 14, 2006 has been received and entered. Claims 10-18 are now pending.
2. Applicant's Amendment has overcome the previous rejections under 35 USC 01, and 112, second paragraph.

Claim Objections

3. Claims 10, 12, 13, and 17 are objected to because of the following informalities:

In claims 10, 12, 13, and 17, the recitation of "for that" and "of for" in various lines which constitute intended use and does not carry patentable weight since it never has to occur. Claims should be amended to recite more firm and positive language (i.e. delete "for").

Appropriate correction is required.

Claim 13, recite "a server" in line 7, again although previously introduced in the same claim in line 3, is this a new server being referenced or the same initial server, if so, the claim should be amended to recite "said" or "the" to eliminate lack of antecedent basis.

Similarly, claim 17, line 6 carry the same deficiency.

Claim Rejections - 35 USC § 102

Art Unit: 2165

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless —

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 10, and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Spencer (U.S. Patent No. 5,826,261).

As to claim 10, Spencer discloses a service for searching documents wherein servers comprising document databases and programs to manipulate said databases are dispersed over a network and a client connected to said servers performs a document search, said service providing a document search method comprising the steps of:

inputting, to a first document database, at least one document retrieved as a result of a first search of said first document database; wherein the first search is conducted by a first search input, to said first document database, of a set of keywords, fragments of document or any desired set of documents (See column 6, lines 1-5, also see column 12, lines 49-67, wherein “result of first search” reads on “first list of terms” are returned to the client in response to first query),

making a weighted term list from said input of said at least one document to said first document database, the weight of each term reflecting the importance of the term in the first document database (See column 13, lines 20-25), and

performing a search of a second document database; wherein said weighted term list is used as a second search input for performing said search of said second document database (See column 6, lines 6-8, and see column 13, lines 35-45), and

wherein each term in the term list is weighted considering the importance of the term both in the first document database and the second document database, and the weight being used to calculate the relevance of each document of the second document database (See column 6, lines 20-27, and see column 14, lines 52-62).

As to claim 18, (rejected as best ability under with respect to 1122nd) Spencer discloses a service for searching documents wherein servers comprising document databases and programs to manipulate said databases are dispersed over a network and a client connected to said servers performs a document search,

said service providing a document search method in which the client transmits a set of documents in a first search input to one of said servers where a first document database is stored, receives a summary comprising only topic words related to the set of documents which is sent (See column 6, lines 1-5, also see column 12, lines 49-67, wherein “result of first search” reads on “first list of terms” are returned to the client in response to first query, and wherein “summary” reads on matching “terms” in results),

sends a second search input corresponding to said summary reflecting a user's evaluation of the summary to a server where a second document database is stored (See column 13, lines 20-25), and

receives a search result from the search of the second document database, wherein said server storing the first document database produces the summary of topic words relevant to the set of documents sent by the client and transmits the summary to the client, and searches and transmits a set of documents having a high relevance to any desired summary sent by the client, to the client (See column 6, lines 6-8, also column 6, lines 20-27, and column 13, lines 35-45, and column 14, lines 52-62).

Allowable Subject Matter

6. Claims 11-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

7. Applicant's arguments filed on 8/7/2006 have been fully considered but they are not persuasive.

In response to Applicant's argument that "Spencer does not teach or suggest an arbitrary set of key documents in the first document database, so that network traffic is reduced to a small amount without complicated system. Spencer does not teach this invention" is acknowledged but not deemed to be persuasive.

In response to applicant's argument that "so that network traffic is reduced to a small amount", a recitation of the intended use of the claimed invention must result in a structural

difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Furthermore, the recitation of “arbitrary set of key documents” is not in the claims.

In response to Applicant’s argument that “Spencer is directed to meta search engines which do not own a database of Web pages in contrast to the present invention” is acknowledged but not deemed to be persuasive.

In response to applicant's argument that the references fail to show certain features of applicant’s invention, it is noted that the features upon which applicant relies (i.e., own a database of Web pages) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The Examiner also points out that if the feature is what is recited in the preamble, and then has not been given patentable weight because the recitation occurs in the preamble. The claims recitation are directed to an input, no specified to be local or remote, thus, can be broadly interpreted in either case.

In response to Applicant’s argument that “Spencer does not teach performing a database search from a first database to a second database by making a query of the documents from the search result of the first database and then searching a second database related to the query documents” is acknowledged but not deemed to be persuasive.

Spencer discloses in column 5, lines 21-31, wherein, the resulting error contribution weights describe the local relative contribution of the first list of terms to document scores in that database based on the user's original query. The documents from which the error contribution weights are determined are preferably selected by the document database by locally executing the user's original query, and selecting a certain number of resulting documents, such as the first n documents based on ranked document scores. The number n can be predetermined, or adaptively determined based on input from the client computer.

Then, the scored list is then actually used as an input for querying the other databases as taught in Spencer column 5, lines 43-50.

Then by producing a single result of the entire document collection (i.e. multiple databases), both first and second databases are searched, thus reading on the claimed invention.

The claims as broadly interpreted state a first search (i.e. Spencer's original query) is conducted on a first document database and based on the results (i.e. Spencer's actual query); a second search is conducted on a second database.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

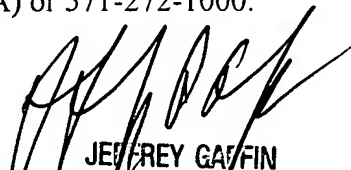
will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neveen Abel-Jalil whose telephone number is 571-272-4074. The examiner can normally be reached on 8:30AM-5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Neveen Abel-Jalil
August 15, 2006


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